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| 09/439,130 | 11/12/1999 | AKIRA SAKAGUCHI | JA9-98-217 | 1265 |
| 36736 | 7590 | 03/09/2005 | EXAMINER | |
| DUKE W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380 | | | BURGESS, BARBARA N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2157 | |

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/439,130

Applicant(s)

SAKAGUCHI, AKIRA

Examiner

Barbara N Burgess

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,7,8 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,7,8 and 12-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

This office action is in response to amendments filed September 7, 2004. Claims 1, 5, 7-8, 12-24 are presented for further examination.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5, 7-8, and 12-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt et al. (hereinafter "Hunt", 5,764,235) in view of Anupam et al. (hereinafter "Anupam", 5,862,330).

As per claims 1, 5, 7-8, Hunt discloses:

- Generating an image file in response to an operator of said client terminal specifying a screen range of said client terminal, wherein the image file is generated based on image data from the specified screen range (column 2, lines 34-40, column 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5, column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-33, 49-51);

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- Acquiring an image file name from said server (column 5, lines 34-55, column 9, lines 29-42, column 10, column 12, lines 1-25);
- Converting said image file to generate a predetermined formed compressed image data which has a file name relating to said unique image file name (column 1, lines 48-51, column 8, lines 50-52, column 9, lines 6-15);
- Sending said predetermined formed compressed image data to said server (column 5, lines 18-33, 65-67, column 8, lines 31-52)

Hunt does not explicitly disclose:

- Posting the file name of said predetermined formed compressed image data to the client terminals collaborating with said client terminal.

However, in an analogous art, Anupam discloses creating and joining a collaborative browsing session. When there is a change in URL, the new URL is communicated to the other collaborators in the session (abstract, column 3, lines 25-41, 60-67, column 4, lines 5-15, 31-40, column 5, lines 35-55). Anupam, therefore, discloses posting the file name of predetermined formed compressed image data to the client terminals collaborating with said client terminal.

Therefore, one of ordinary skill in art at the time the invention was made would have found it obvious to incorporate or implement posting a file name of image data to the client terminals collaborating with client terminal in Hunt's method in order to display new URL's to the other computers in the collaboration session.

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As per claims 12, 17, and 20, Hunt discloses wherein the operator specifies a screen range of said client terminal by manipulating a mouse to define a frame, wherein the frame encloses the screen range (column 2, lines 34-40, column 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5, column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-23, 49-51).

As per claims 13, 18, and 21, Hunt discloses the operator specifying a screen range of said client terminal by selecting an application window, wherein a frame of the application window defines the screen range (column 2, lines 34-40, column 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5, column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-23, 49-51).

As per claims 14, 19, and 22, Hunt discloses acquiring a device context of a desktop window and generating a desktop window image corresponding to the device context of the desktop window, wherein the screen range is a portion of the desktop window (column 2, lines 34-40, column 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5, column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-23, 49-51).

As per claims 15 and 23, Hunt discloses wherein the operator of said client terminal specifies the screen range during a capture mode (column 2, lines 34-40,

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column 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5, column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-23, 49-51).

As per claims 16 and 24, Hunt discloses suspending the capture mode, receiving input from the operator to activate a hidden window image and resuming the capture mode (column 2, lines 34-40, column 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5, column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-23, 49-51).

Response to Arguments

The Office notes the following arguments:

- (a) Neither Hunt nor Anupam teaches or suggests generating an image file in response to an operator of client terminal specifying screen range of said terminal, wherein the image file is generated based on image data from the specified screen range.
 - (b) One of ordinary skill in the art, being presented only with Hunt and Anupam, and without prior knowledge of Applicant's invention, would not have found it obvious to combine and modify Hunt and Anupam to arrive at Applicants' claimed invention.
3. Applicant's arguments filed have been fully considered but they are not persuasive.

In response to:

(a) Hunt discloses sending to the server from the client image control information.

This information includes data or information obtained from the client that is useful in determining both the suitable amount of data and/or format for the graphical image files to be sent. The user has a choice as to the amount of a graphical image file needed. For example, if images are simply being displayed in a small one-inch by one-inch arrangement, then only a small amount of the graphical image file need to be transmitted. Hunt plainly discloses the operator of the client machine specifying image control information that takes into account the screen range. As stated above, it could be a one by one inch arrangement (screen range). The arrangement is the screen range. The size of the arrangement (screen size) is specified by the user in the image control information (column 2, lines 34-40, column 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5, column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-33, 49-51). Therefore, Hunt discloses generating an image file in response to an operator of client terminal specifying screen range of said terminal, wherein the image file is generated based on image data from the specified screen range.

(b) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, combining Hunt and Anupam would enable new URL's to be displayed to in order to display new URL's to the other computers in the collaboration session.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N Burgess whose telephone number is (571) 272-3996. The examiner can normally be reached on M-F (8:00am-4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Barbara N Burgess
Examiner
Art Unit 2157

March 5, 2005



SALEH NAJJAR
PRIMARY EXAMINER